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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,752	05/22/2001	Peter J. Kuzma	9905-20	9127
26294	7590	03/21/2006	EXAMINER	
TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P. 1300 EAST NINTH STREET, SUITE 1700 CLEVEVLAND, OH 44114			LEE, BENJAMIN C	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,752

Applicant(s)

KUZMA ET AL.

Examiner

Benjamin C. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-10 and 12-24 is/are rejected.
7) ☒ Claim(s) 11 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Amendment

Claim Status

1. **Claims 1-24** are pending.

Claim Rejections - 35 USC § 103

2. **Claims 1 and 5-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle et al. (US pat. #6,045,652) in view of Stanfield et al. (US pat. #5,751,221) as stand in the previous Office action.

3. **Claim 2, 9-10 and 16-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle et al. in view of Stanfield et al. and Brady et al. (US pat. #6,201,474).

- 1) Claim 2, 9-10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle et al. in view of Stanfield et al. and Brady et al. (US pat. #6,201,474) as stand in the previous Office action.

- 2) Regarding amended claim 17, Tuttle et al., Stanfield et al. and Brady et al. render all of the claimed subject matter obvious as in claim 16, plus the consideration of claim 9.

4. **Claims 3 and 12-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle et al. in view of Stanfield et al. and Isaacman et al. (US pat. #5,936,527) as stand in the previous Office action.

5. **Claims 18-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle et al. in view of Scott et al. (US pat. #6,121,880).

- 1) Claim 18, Tuttle et al. and Scott et al. render all of the claimed subject matter obvious

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as stand in the previous Office action.

2) Regarding amended claims 19-20, Tuttle et al. and Scott et al. render all of the claimed subject matter obvious as in claim 18, plus the consideration of claims 7-8, respectively.

3) Regarding new claims 21-22, Tuttle et al. and Scott et al. render all of the claimed subject matter obvious as in the consideration of claim 18, wherein:

--the claimed retrofitting constitutes an intended use recited only in the preamble of the claim, and furthermore it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that the method steps recited in the claim are no different than those would have involved in application of the transponder labels in Tuttle et al. and Scott et al. to objects intended for tracking.

6. **Claims 4, 14-15 and 23-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle et al. in view of Scott et al. (US pat. #6,121,880) and Smith et al. (US 6,281,795).

1) Regarding claims 4 and 14-15, Tuttle et al. and Scott et al. render all of the claimed subject matter obvious as stand in the previous Office action, while:

Smith et al. teaches a transponder/label assembly attachment to an object using the claimed adhesive layer that includes pressure sensitive adhesive such that the transponder/label assembly is releasably attached to and removable from an object (Abstract and Figs. 4, 6).

In view of the teachings by Tuttle et al., Scott et al. and Smith et al., it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to use a known pressure sensitive adhesive as taught by Smith et al. as the adhesive in Tuttle et al. and Scott et al. so that the transponder/label assembly can be removed when the intended user so desires, such as after location tracking on the particular object has been terminated or no longer needed.

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2) Regarding claims 23-24, Tuttle et al. and Scott et al. render obvious all of the claimed subject matter as in claim 21, plus the consideration of claim 4 further in view of Smith et al., whereby regarding claim 24, since the transponder assembly is removable, it can be reused if so desired as a recycling/reusing process to reduce waste and cost.

Allowable Subject Matter

7. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 3/21/05 have been fully considered but they are not persuasive.

1) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

2) Regarding claim 1, Applicant argues about the "uniform" or flat profile of the transponder assembly being not met by Tuttle et al., however, such uniformity limitation has not been recited in claim 1. The Tuttle et al. drawings also exaggerated the dimensions in some figures to show detail, as is evident from comparing the thickness in different figures. Furthermore, Tuttle et al. discloses on col. 2, lines 32-35 that the transponder assembly is about 0.03 inches thick which is only slightly larger and thicker than a postage stamp. Therefore,

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Applicant's argument that the Tuttle transponder, due to its uneven surface and projection, would not be applicable to the intended use of being attached or embedded in a file cover is not persuasive.

In the combination of Tuttle et al. and Stanfield et al., Stanfield et al. teaches the known use of "transceiver" attached to a file for its identification and location, and provides suggestion for the combination because the "transponder" of Tuttle et al. is a specific type of "transceiver", so that the object location tracking transponder of Tuttle et al. can specifically be attached/embedded on a file as a specific type of object as a known intended use as a result of the Stanfield et al. teaching as indicated in the Office action rejection.

3) Regarding the rejection of claims 2 and 9, the combination of Tuttle et al., Stanfield et al. and Brady et al. teaches embedding a transponder including its antenna in a slot/recess in the object intended for application, and therefore the antenna is being embedded in the object. One skilled in the art would have readily recognized that the references are in the same/analogous art, since they are all directed to physical attachment of a transceiver/transponder to an object.

4) Regarding claims 10 and 16-17, if the transponder having contacts is attached/embedded in the file so that the file comprises the transponder and its contacts in the Tuttle et al., Stanfield et al. and Brady et al. combination, then the file "comprises a pair of contacts" in the combination. The rejection stands, because the claims do not require the joining of the file contacts and the transponder circuitry by an end user, e.g. as per claim 11.

5) Claim 11 has been allowed.

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6) Regarding the rejection of claims 3 and 12-13, the combination of Tuttle et al., Stanfield et al. and Isaacman et al. meeting the claimed invention is appropriate for the same reasons given above (since applicant relied arguments that are rebutted above.)

7) Regarding the rejection of claims 4 and 14-15, the combination of Tuttle et al. and Scott et al. met the claimed backing sheet (release liner) as indicated in the rejection.

8) Regarding claims 18-20, claim 18 recites “A transponder label assembly *consisting* of: a transponder assembly *including*: ...” therefore while it is true that the “transponder label assembly” may include only a transponder assembly and a backing sheet, the “transponder assembly” may “include” those cited limitations following it and more. As such, everything in the combined teaching of Tuttle et al. and Scott et al. other than the “backing sheet” can be designated the “transponder assembly” thereby meeting the claimed limitations.

9) New claims 21-24, as well as amended claims 4 and 14-15, have been rejected as indicated above. See above rejection for detail.

10) In conclusion, Applicant’s arguments are not deemed persuasive, and the above rejection is thus maintained.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) Monico, US 6259369

--Similar known inclusion of antenna and attachment contacts on envelopes, and end user attaches transponder circuit chip to mate with the contacts to complete the assembly.

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin C. Lee whose telephone number is (571) 272-2963. The examiner can normally be reached on Mon -Thu 11:00Am-7:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Benjamin C. Lee
Primary Examiner
Art Unit 2632

B.L.